

REMARKS REGARDING EXAMINER'S EXPLANATION OF NON-COMPLIANCE

The Examiner's comments regarding the prior response have been noted and the remarks below correct the text to be consistent with the fact that claims 1-10 are as originally filed and that no amendments to the claims have yet been made.

REMARKS TRAVERSING RESPONSE TO RESTRICTION REQUIREMENT

Reconsideration and withdrawal of the restriction and species election are respectfully requested in view of the remarks herewith.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

(1) Undue Burden Requirement Has Not Been Met for Non-consideration of Group VIII

The compound of formula (V) is part of the method of making claim 4 and therefore the search for this process would necessarily require a search of this compound as well. Indeed, the search and examination of each Group would be likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

(2) Even If Restriction Is Maintained, Claims 8-10 Are Linked and Must Be Examined

MPEP 809.03 (Linking Claims) states in part:

“There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called “linking” claims) inseparable therefrom and thus linking together the inventions otherwise divisible. The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) a claim to the necessary process of making a product linking proper process and product claims;
- (C) a claim to “means” for practicing a process linking proper apparatus and process claims; and
- (D) a claim to the product linking a process of making and a use (process of using).”

As each of claims 8-10 are directed toward making the compounds of claim 1, (b) – a claim to the necessary process of making a product linking proper process and product claims – is most analogous. ~~Based upon the Examiner's Restriction and the amendments made to the claims, claims~~ ~~Claims~~ 8-10 are linked to the invention of claim 1, i.e. are species of the genus represented by claim 1 and ~~claims 40 and 54 as amended are linked to the invention of claim 11.~~

MPEP 809 (Claims Linking Distinct Inventions) states in part:

"The linking claims **must be examined** with invention elected, and should any linking claim be allowed, the restriction requirement **must be withdrawn**. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all of the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, non-elected claim(s) which depends from or includes all of the limitations of the allowable linking claim **may be reinstated** by submitting claim(s) in an amendment. Upon entry of the amendment, the amended claim(s) will be fully examined for patentability." (emphasis added)

Consistent with MPEP 809, it is respectfully requested that the linking claims be examined with the invention elected.

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested.

NOTE FOR EXAMINER PRIOR TO EXAMINATION

~~Should the claims be held to be otherwise allowable, the applicants authorize an Examiner's amendment to delete the phrase "R⁴ and R⁵ are hydrogen" as the compound of formula (V) does not contain these variables.~~

It is also believed that the application is in otherwise in condition for allowance, and favorable consideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

Favorable action is earnestly solicited.

Respectfully submitted,

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